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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,145	01/31/2001	Tetsuo Yoshida	Q62887	1868

7590

10/24/2002

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 10/24/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/762,145

Applicant(s)

YOSHIDA ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 2,12-24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Applicant's response filed on 08/16/2002 has been fully considered. Claims 1-26 are pending. Claims 2, 12-24 and 26 are non-elected and withdrawn from consideration.

### *Election/Restrictions*

ok 2. Applicant's election of Group I claims 1 and 25 along with generic claims 3-11 in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### *Claim Objections*

3. Claims 1, 3-11 and 25 are objected to because of the following informalities:

ok a. Claims 3-11 are dependent upon claim 1 or **non-elected** claim 2. Elected claims cannot be dependent upon non-elected claims. Appropriate correction is required.

ok b. Claim 11 recites the limitation "the coating film" in line 1. There is insufficient antecedent basis for this limitation in the claim. The coating film in claim 11 does not exist in claim 1, but it does exist in non-elected claim 2.

ok c. Claim 25 recites the limitation "the laminate film" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention. The applicant has failed to incorporate a foreign test standard in the specification.

The incorporation of essential material by reference to a foreign application or foreign patent or to a publication inserted in the specification is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or applicants attorney or agent, stating that the amendatory material consists of the same application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157; *In re Hawkins*, 486 F.2d 569, 179 USPQ 163; *In re Hawkins*, 486 F.2d 569, 179 USPQ 167.

ck.  
In order to avoid a 35 U.S.C. § 112, first paragraph rejection when the applicant attempts to incorporate a foreign test standard in the specification (see page 8, line 32; page 18, line 25; page 20, line 29 and page 21, line 9), it is recommended that the applicant further incorporates the standard in the specification or submit an English translation of the standard.

Claims 1, 3-11 and 25 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 5 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

0✓ a. The terms "a\*" and "b\*" render the claim ambiguous. The term is neither defined in the specification nor does it have a well-defined meaning in the art.

0✓ b. Claim 25 provides for the use of laminate film, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 25 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

- 2  
9. Claims 1, 4 and 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa et al. (US 6,420,010).

With.  
Hasegawa discloses a white laminated polyester film, wherein one of the layers i.e. layer A comprises a polyethylene terephthalate, up to 10 % by wt of titanium oxide having an average particle diameter of 0.1-0.5 um and 0.01-0.1 % by wt of silicon dioxide having an average particle diameter of 0.6-2.0 um (col. 3, lines 21-35). The intensity ratio of the film is greater than or equal to 0.15 and smaller than or equal to 0.4 (col. 8, line 9), and the film has frictional coefficient smaller than 0.35 (col. 6, line 55). The film has surface roughness of 0.08-0.103 um (col. 6, line 53) and a molecular orientation ratio of 1.0-1.5 (col. 8, line 37).

With respect to glossiness and optical density value it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Hasegawa reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Since Hasegawa is silent regarding thermal heat shrinkage value the examiner interprets the value to be zero, which falls within the claimed range, that is 2% or less.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*keep* *includ all pending claims*  
11. Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Hasegawa et al. (US 6,420,010) in view of Fukuda et al. (US 5,958,552).

Hasegawa discloses a white laminated polyester film, wherein one of the layers i.e. layer A comprises a polyethylene terephthalate, up to 10 % by wt of titanium oxide having an average particle diameter of 0.1-0.5 um and 0.01-0.1 % by wt of silicon dioxide having an average particle diameter of 0.6-2.0 um (col. 3, lines 21-35). The intensity ratio of the film is greater than or equal to 0.15 and smaller than or equal to 0.4 (col. 8, line 9), and the film has frictional coefficient smaller than 0.35 (col. 6, line 55). The film has surface roughness of 0.08-0.103 um (col. 6, line 53) and a molecular orientation ratio of 1.0-1.5 (col. 8, line 37).

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teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Fukuda teaches a polyethylene terephthalate film to be used as a base sheet for an ink jet printing, wherein the film comprises silica and titanium oxide (col. 1, line 19; col. 2, lines 46-58 and col. 4, line 51). The film has a thickness of the film is 50-150 um (col. 5, line 44).

Hasegawa and Fukuda are analogous art because they are from the same field of endeavor that is the polyester film art. At the time of the invention, it would have <sup>the</sup> been obvious to a person of ordinary skill in the art to combine ~~the polyethylene~~ <sup>the lacking of film thickness of</sup> ~~terephthalate film of Fukuda~~ with the invention of Hasegawa so as to provide a polyester film that can be fed into a conventional ink jet printer. The polyester film has to be thick enough to avoid jamming and thin enough to avoid folding in the printer.

### **Conclusion**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

A handwritten signature in black ink, appearing to read 'Cynthia H. Kelly', written in a cursive style.

BS *BS*  
October 21, 2002.